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In re Application of:
LEPPARD ET AL.
Application No.: 09/856,769
PCT No.: PCT/EP99/08968
Int. Filing Date: 20 November 1999
Attorney's Docket No.: A-21884/A/PCT
For: PROCESS FOR THE PREPARATION OF
ACYLPHOSPHINES, ACYL OXIDES
AND ACYL SULFIDES

DECISION ON
UNDER 37 CFR 1.47(a)

This decision is in response to applicant's petition under 37 C.F.R. 1.47(a), filed 14 January 2002, to accept the above-identified application without the signature of co-inventor Rene Kaeser.

BACKGROUND

On 20 November 1999, applicants filed international application PCT/EP99/08968, which claimed a priority date of 30 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 June 2000. A Demand for international preliminary examination, in which the United States was elected, was timely filed on 30 May 2000. Accordingly, the thirty-month period for meeting the requirements for entry into the national stage expired at midnight on 30 May 2001.

On 22 May 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic filing fee and a copy of the International application.

On 5 July 2001, the United States Designated/Elected Office (PTO) mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) was required as well as the surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)). Applicants were given a TWO (2) MONTH period from the mail date of the Notification to properly respond, with extensions of time obtainable under 37 C.F.R. 1.136(a).

On 14 January 2002, applicants timely filed the instant petition under 37 CFR 1.47(a) which included a certificate of mailing dated 4 January 2002, a declaration under 37 CFR 1.63 which was unsigned only by co-inventor Rene Kaeser, a declaration in support of the instant petition asserted by Hans-Peter Wittlin, a petition for a four month extension of time for reply within the sixth month which ended at midnight of 7 January 2002, and the surcharge as required under 37 CFR 1.492(e), and the requisite fee for filing the instant petition. The fees for the extension of time and the surcharge have been charged to applicant's deposit account as requested. A petition fee of \$130.00 will be charged to applicant's Deposit Account No. 03-1935 (37 CFR 1.17(h)).

DISCUSSION

Petition to File When An Inventor Refuses To Sign or Cannot Be Reached under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Applicants have satisfied items (1), (3), and (4) above.

Regarding item (2) above, MPEP 409.03(d) (August 2001) states in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a non-signing inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a non-signing inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Based upon the supporting declaration, Hans-Peter Wittlin was not present when the oral refusals were made. Therefore, the supporting documentation submitted with the petition contains statements by a party not present when an oral refusal was made. Accordingly, these statements will not be accepted. It is further unclear as to the content of the "application" sent to co-inventor Kaeser on 8 May 2001. MPEP 409.03(d) requires that the application papers include the specification, drawings, claims, and oath or declaration. It would appear as though co-inventor Kaeser received the declaration documents. However, the supporting documentations do not clearly indicate the content of the application to include the specification, drawings, and claims.

In that Item (2) has not been satisfied, the present petition under 37 CFR 1.47(a) may not properly be granted at this time.

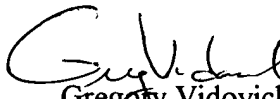
It is noted that in paragraph "3" of the supporting declaration, it is stated that a "copy is enclosed of his employment contract." However, this copy was not present in the papers filed by applicants on 14 January 2002.


CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Failure to timely submit the proper reply will result in ABANDONMENT. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.


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